

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIRK C. WICKIZER
and JEFFREY P. WICKIZER

Appeal No. 1999-1754
Application 08/800,230¹

HEARD: Dec. 9, 1999

Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner
finally rejecting claims 1-10, which constitute all of the
claims of record in the application.

¹Application for patent filed February 12, 1997.

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The appellants' invention is directed to a handle for a fishing rod. The claims before us on appeal have been reproduced in an appendix to the Appeal Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Sleight 1937	2,091,458	Aug. 31,
Strader 1987	4,653,215	Mar. 31,

THE REJECTIONS

Claims 1, 2, 4, 6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Strader.

Claims 3, 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Strader.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Strader in view of Sleight.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellants regarding the rejections, we make reference to the

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Examiner's Answer (Paper No. 11) and the Appellants' Briefs
(Paper Nos. 10 and 12).

OPINION

The Rejection Under 35 U.S.C. § 102(b)

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See ***In re Paulsen***, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and ***In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Independent claim 1 and dependent claims 2, 4, 6 and 8 stand rejected as being anticipated by Strader. Claim 1 is directed to the combination of a fishing rod having a handle and a "leverage feature" projecting from one side of the handle "and extending from a bottom portion to a top portion" of the handle "so as to be engaged by the side of the hand of a user gripping said rod handle with a palm grip,"² with the

²The "palm grip" is described on page 1 of the appellants' specification (lines 11-16) as being a known grip in which the

thumb extending atop the reel and with the little, ring, and middle fingers encircling said handle just forward of said leverage feature."

Strader discloses a fishing rod and reel system in which the handle is provided with front and rear protuberances (unnumbered in the drawing and unmentioned in the text) extending from the handle as shown in Figures 1 and 2.³ From the drawings, it would appear that the front protuberance is trigger-like and extends downwardly only from the handle, while the rear protuberance extends downwardly and outwardly around each side to some extent. We do not agree with the examiner that Strader discloses all of the subject matter recited in claim 1, and therefore we will not sustain the rejection of claim 1 or, it follows, of claims 2, 4, 6 and 8, which depend therefrom. Our reasoning follows.

While it is clear that the rear protuberance of Strader extends downwardly from the bottom portion of the handle, it cannot be determined from the disclosure that it extends "to a

user rests the thumb on the top of the reel.

³Notwithstanding the designations provided in column 1, it would appear that Figure 2 shows a side view of the Strader fishing rod and Figure 3 a top view.

top portion." Thus, one of the requirements of claim 1 is lacking in Strader. Furthermore, it also cannot be determined that the rear protuberance is so located as to be engaged by the side of the hand when grasping the handle in the operating position, also as required by the claim. Finally, the manner in which the user's hand is shown as engaging the handle in Strader's Figure 1 is not the "palm grip" recited in claim 1, and it would appear that the reel is too far from the grip portion of the handle to allow the rear protuberance to be engaged by any part of the hand if the hand were to be positioned so that the thumb is on top of the reel, as is required by the "palm grip." Thus, this structural relationship also is not disclosed by Strader.

The Rejections Under 35 U.S.C. § 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine

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reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Claims 3, 5 and 7, all of which depend from claim 1, stand rejected as being unpatentable over Strader. It is the examiner's position that it would have been obvious to one of ordinary skill in the art to locate the leverage feature the claimed predetermined distance from the back of the reel (claims 3 and 5) as a result of routine experimentation, and that to provide adjustable mounting means for the reel (claim 7) would have "been within the purview of one skilled in the art" (Paper No. 3, page 2). Be that as it may, even considering Strader in the context of Section 103, it is our view that the shortcomings of the reference discussed above with regard to the Section 102 rejection of claim 1 are not

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overcome. Not only is the structure recited in independent claim 1 not explicitly taught by this reference, but we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the rod disclosed therein in such a manner as to meet the terms of dependent claims 3, 5 and 7 which, of course, include the structure of claim 1. Thus, a *prima facie* case of obviousness has not been established with regard to the subject matter of claims 3, 5 and 7, and we therefore will not sustain the rejection of these claims.

We reach the same conclusion with regard to claims 9 and 10, which are dependent from claim 1 and stand rejected as being unpatentable over Strader in view of Sleight. The secondary reference, which was cited for its teaching of mounting a leverage feature on a separate piece attached around the handle, fails to cure the defects in Strader pointed out in the foregoing paragraphs. Thus, a *prima facie* case of obviousness is lacking with regard to the subject matter of claims 9 and 10, and we will not sustain this rejection.

SUMMARY

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None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

	Irwin Charles Cohen)	
	Administrative Patent Judge)	
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)	
	Neal E. Abrams)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Jennifer D. Bahr)	
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